

### **REMARKS/ARGUMENTS**

Claims 1-35 are pending in the current application. The Examiner has rejected Claims 1, 2, 6, 8-10, 12, 13, 15-17, 22-24, 26, 28 and 30-34. The Examiner has objected to Claims 3-5, 7, 11, 14, 18-21, 25, 27, 29 and 35 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claims 2 and 34 have been amended to correct minor typographical errors.

### **Claim Rejections – 35 U.S.C. §102**

The Examiner rejected Independent Claim 34 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,420,124 to Coulson (hereinafter "Coulson '124"). Coulson '124 discloses, referring to Figs. 1, 5 and 7, a compressor including a motor having rotor 14 which defines compression chamber 30, first and second end discs, or plates, 13 fastened to rotor 14 which define opposite ends of compression chamber 30, stationary shaft 16, piston 28 mounted to shaft 16, and vane 35 having a first end received within rotor 14 and a second end slidably received within slot 36 of piston 28.

Amended Claim 34 calls for a rotary compressor assembly including, *inter alia*, a motor having a rotor defining a compression chamber, a first plate and a second plate fixed relative to the rotor and defining opposite ends of the compression chamber, a stationary shaft, a roller rotatably mounted on the stationary shaft and disposed within the compression chamber, a vane having an outer radial end fixed to the rotor and extending radially inwardly, *the vane being fixed to the first and second plates proximate a radial inner end of the vane.*

Coulson '124 does not disclose or suggest a vane *fixed to first and second plates* defining opposite ends of a compression chamber, as called for in Claim 34. Rather, referring to Fig. 7 of Coulson '124, the top and bottom of vane 35 are flush with the top and bottom of piston 28 and are not fixed to end plates 13. Further, Coulson '124 does not disclose or suggest that the vane is fixed *proximate the radial inner end* of the vane. Referring to para. [0037] of the present application, having a radial outer end of the vane fixed to the rotor and a radial inner end of the vane fixed to the first and second plates reduces the deflection and stresses within the vane, thereby reducing the possibility of breaking the vane. Vane 35 of Coulson '124, as it is not fixed to top and bottom plates 13 proximate its inner radial end,

Application Serial No. 10/796,711  
Amendment dated May 9, 2006  
Reply to Office Action dated March 3, 2006

does not receive this benefit.

In view of the above, Coulson '124 does not disclose or suggest all of the limitations of Claim 34. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejection thereof.

### **Claim Rejections – 35 U.S.C. §103**

The Examiner rejected Independent Claims 1, 17 and 33, and Claims 2, 6, 8-10, 12, 13, 15, 16, 22-24, 26, 28, and 30-32 depending therefrom, as rendered obvious under 35 U.S.C. §103(a) by U.S. Patent No. 2,415,011 to Hubacker (hereinafter "Hubacker '011") in view of U.S. Patent No. 1,964,415 to Van Deventer (hereinafter "Van Deventer '415").

Independent Claims 1 and 33 call for a rotary compressor for compressing a working fluid comprising, *inter alia*, a housing including an oil sump, a stationary shaft extending into the housing and including a longitudinal passage having an oil inlet in fluid communication with the oil sump *and* a working fluid inlet configured to receive the working fluid. Similarly, Independent Claim 17 calls for a compressor having a stationary shaft including a longitudinal passage having a lubricant inlet *and* a working fluid inlet configured to receive working fluid.

Hubacker '011 discloses, referring to Fig. 1, a compressor including stationary shaft 18 having longitudinal passage 41 extending therethrough for receiving a working fluid and communicating the working fluid into inlet passages 43 and 45 of the compressor mechanism. As acknowledged by the Examiner, Hubacker '011 fails to disclose that longitudinal passage 41 has an oil inlet, as called for in Claims 1, 17 and 33. Van Deventer '415 discloses, referring to Fig. 1, a compressor including rotatable shaft 50 having longitudinal passage 80 extending threthrough for receiving oil from an oil sump in the compressor and communicating the oil to passages 82 and 83 in order to lubricate the moving parts of the compressor. However, Van Deventer '415 fails to disclose that the longitudinal passage has a working fluid inlet, as called for in Claims 1, 17 and 33.

Applicant submits that the combination of Hubacker '011 with Van Deventer '415 would not produce the compressors claimed in Independent Claims 1, 17 and 33. More particularly, Hubacker '011 discloses a passage in a compressor shaft exclusively used for

communicating a working fluid while Van Deventer '415 discloses a passage in a compressor shaft exclusively used for communicating oil. Nowhere do these references disclose or suggest a single passage having an oil inlet and a working fluid inlet. Thus, combining these references would produce a compressor having a shaft with two passages, one for exclusively communicating oil, the other for exclusively communicating refrigerant. Claims 1, 17, and 33 do not claim such a device, rather, they claim a shaft having a passage having one inlet for receiving a working fluid and a second inlet for receiving an oil, or lubricant. As discussed in para. [0035] of the present application, oil may flow into the longitudinal passage through the oil inlet and mix with working fluid entering the longitudinal passage from the working fluid inlet. As a result, the oil may be entrained with the working fluid and lubricate the moving components of the compressor. This advantage is not achieved with the passages disclosed in Hubacker '011 and Van Deventer '415, or the combination thereof.

Further, it is well settled that, "(t)he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)). Not only does the Examiner bear the burden of showing a teaching or suggestion to combine references to establish a 35 U.S.C. § 103 obviousness rejection, but the Examiner must also indicate where such a teaching or suggestion can be found in the relevant references. See, *In re Yates*, 663 F.2d 1054 (C.C.P.A. 1981) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference). Applicant respectfully submits the Examiner has not met their burden of indicating where a motivation to combine Hubacker '011 and Van Deventer '415 can be found.

Additionally, Independent Claims 1 and 17 call for a roller rotatably mounted on a stationary shaft, a motor having a stator and a rotor, the rotor being rotatably mounted on the shaft, *the roller being coupled to the rotor*. Applicant submits that neither Hubacker '011 nor Van Deventer '415 disclose or suggest a roller coupled to a rotor, as called for in Claims 1 and 17. Rather, Hubacker '011 discloses, referring to Fig. 2, that rotatable outer ring 22 of the rotor is rotated with respect to inner ring, or roller, 25 and thus is not coupled to roller 25.

Application Serial No. 10/796,711  
Amendment dated May 9, 2006  
Reply to Office Action dated March 3, 2006

More specifically, outer ring 22 includes vane assembly 27 which contacts and slides over the outer surface of roller 25 to separate suction and discharge pockets in the compression chamber defined between roller 25 and outer ring 22. Van Deventer '415 discloses, referring to Fig. 2, rotor 68 rotated within cylinder 64 wherein rotor 68 includes four vanes 70 which contact and slide across the inner surface of cylinder wall 62 to separate suction and discharge pockets in the compression chamber. Van Deventer '415 does not disclose a roller, let alone a roller coupled to the rotor. As a result, neither Hubacker '011 nor Van Deventer '415 disclose a roller coupled to a rotor, as called for in Claims 1 and 17.

In view of the above, Hubacker '011 and Van Deventer '415 do not disclose or suggest all of the limitations of Independent Claims 1, 17 and 33, and Claims 2, 6, 8-10, 12, 13, 15, 16, 22-24, 26, 28, and 30-32 depending therefrom. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection thereof.

#### **Allowable Subject Matter**

The Examiner indicated that Claims 3-5, 7, 11, 14, 18-21, 25, 27, 29 and 35, which depend from Independent Claims 1, 17 and 34, would be allowable if rewritten in independent form. Applicant respectfully submits that Claims 3-5, 7, 11, 14, 18-21, 25, 27, 29 and 35 are in condition for allowance for at least the reasons advanced above with respect to the independent claims from which they depend.

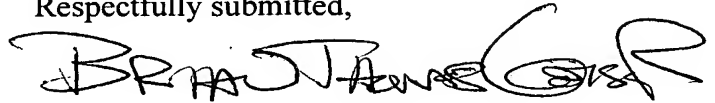
It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically, Applicant respectfully submits that the application is in condition for allowance and respectfully requests allowance thereof.

In the event Applicant has overlooked the need for an additional extension of time, payment of fee, or additional payment of fee, Applicant hereby petitions therefore and authorizes that any charges be made to Deposit Account No. 02-0385, Baker & Daniels.

Application Serial No. 10/796,711  
Amendment dated May 9, 2006  
Reply to Office Action dated March 3, 2006

Should the Examiner have any further questions regarding any of the foregoing, she is respectfully invited to telephone the undersigned at 260-424-8000.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: May 9, 2006

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Name of Registered Representative

  
Signature

May 9, 2006

Date